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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,508	04/13/2001	Tomoo Hayakawa	450100-03162	5789

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER	
NGUYEN, HUY THANH	
ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/834,508	HAYAKAWA ET AL.	
	Examiner	Art Unit	
	HUY T. NGUYEN	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-10 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 10 direct to information stored on a tape . Since the information do not have any functional interrelationship to the tape to control the tape to access the information or impart to any software and hardware structural components to provide certain function that is processed by a computer the information do not make them statutory .

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinohara (5,740,306).

Regarding claim 7, Shinohara discloses a magnetic tape playback apparatus (Fig. 21) for reading, by a rotary head, digital data containing the address of search data on the display picture (a frame) , which is recorded in a magnetic tape, said magnetic tape playback apparatus comprising:

extraction means (ID and for extracting said address of said search data on the display picture from said read digital data (column29, lines 45-60)

combining means (66,64,65) for performing combining by placing said search data at a predetermined position on the basis of said extracted address (column 29, lines 45-60) ; and

output means for outputting said search data combined by said combining means as one image.

Method claims 8 and 9 correspond to apparatus claim 7. Therefore, method claims 8 and 9 are rejected by the same reason as applied to apparatus claim 7.

Further for claim 9. Shinohara a teaches a program stored on a medium for performing the method of the claim since the reproducing of the search data is controlled and processed by a controller.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (5,684,915) in view of Shinohara (5,740,306).

Regarding claims 1 and 10, Ueda teaches a magnetic tape recording apparatus (Figs. 1-5) for recording digital data in tracks of a magnetic tape by a rotary head, said magnetic tape recording apparatus comprising:

video data creation means for coding an input video picture in order to create video data;

search data creation means (special replay data) for creating search data on the basis of said video data; and

formatting means for performing formatting so that said video data and said search data are stored in said tracks of said magnetic tape (Fig. 54) ,

wherein said formatting means places a predetermined number of sync blocks in one of said tracks, places, in one of said sync blocks, a detection pattern for detecting a sync block, identification information for identifying said sync block, main data, and, and places the address corresponding to said stored search data on the display picture (each recoded sync block having a address) , in said main data of said sync block when said sync block stores said search data (column 51, lines 15-40, column 52, line 55 to column 53, line 37) .

Ueda fails to specifically teach using an error-correcting intra code for said identification information and said main data.

Shinohara teaches a recording apparatus for recording normal data and search data (special data) having means for generating an error-correcting intra code for said identification information and said main data (column 19, lines 60-68).

It would have been obvious to o of ordinary skill in the art to modify Ueda with Shinohara by using a generating means as taught by Shinohara with Ueda apparatus for generating an error-correcting intra code for said identification information and said main data thereby accurately identifying and processing the data.

Regarding claim 2, Ueda as modified with Shinohara further using a bit rate control means data creation means (See Shinohara , Abstract, column 31,lines 15-35).

Regarding claim 3, Ueda as modified with Shinohara further teaches a bit rate control means for controlling the bit rate of said search data output by said search data creation means (See Shinohara , column 17 lines 50-67, column 31, lines 15-35).

Regarding claim 4, Ueda as modified with Shinohara further teaches 4. A magnetic tape recording apparatus according to Claim 1, further comprising signal generation means for generating a signal for indicating the position at which said search data is stored in said track of said magnetic tape (See Shinohara column 37, lines 20- 47)

Method claims 5 and 6, correspond to apparatus claim 1. Therefore method claims 5 and 6 are rejected by the same reason as applied to apparatus claim 1.

Further for claim 6, Ueda as modified with Shinohara teaches a program stored on a medium for performing the method of the claim since Ueda and Shinohara both teach that the recording , processing and recording are controlled a control means .

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

HUY NGUYEN
PRIMARY EXAMINER